

REMARKS

Status Of Application

Claims 1-41 are pending in the application; the status of the claims is as follows:

Claims 1-6, 13-24, and 30-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,607,332 to Goldberg (“Goldberg”) in view of U.S. Patent No. 5,450,589 to Maebayashi et al. (“Maebayashi”).

Claims 7-12 and 25-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldberg, in view of Maebayashi, and further in view of U.S. Patent No. 6,074,434 to Cole et al. (“Cole”).

Claim 29 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldberg, in view of Cole, and further in view of Maebayashi.

Claims 37-41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Goldberg in view of U.S. Patent No. 6,260,157 B1 to Schurecht et al. (“Schurecht”).

Claim Amendments

Claims 1, 7, 19, and 25 have been amended to improve the form thereof. Claim 24 has been amended to correct antecedent basis. These changes do not introduce any new matter.

35 U.S.C. § 103(a) Rejections

The rejection of claims 1-6, 13-24, and 30-36 under 35 U.S.C. § 103(a), as being unpatentable over Goldberg in view of Maebayashi, is respectfully traversed based on the following.

In applying 35 USC §103, the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination. MPEP 2141.

Goldberg teaches a method of providing updated firmware routines. In Goldberg, each firmware routine (100) begins with a call to a processing routine (200) with a parameter P unique to the original firmware routine. The processing routine examines the parameter P to determine if the original firmware routine has been replaced by a routine in RAM. If the original routine has not been replaced, execution returns to the original firmware routine (path 312). However, if there is a replacement routine, the processing routine adjusts the processor state and then branches to the replacement routine (branch 311). See Fig. 1 and column 2, line 31-68. Thus, Goldberg teaches that the original firmware routines remain in and are executed from ROM and replacement routines are executed from RAM.

Taken as a whole, Maebayashi also teaches a method of providing updated firmware routines. In Maebayashi the firmware is loaded into a working program storage (4, RAM 52) from fixed program storage 5. The routines stored in the working storage are then modified by data stored in the modification data storing unit (6). See Figs. 1 and 3; column 7, lines 17-25. Thus, Maebayashi teaches that the original firmware routines are loaded into RAM, the contents of RAM are modified to update the firmware, and then the routines (modified or not) are executed from RAM.

Clearly, Goldberg and Maebayashi take two entirely different approaches to providing updated firmware. For example, in the system taught by Goldberg when each routine is executed a test is performed to determine whether the routine has been updated; whereas, in the system taught by Maebayashi no tests are needed because the program in the working memory is kept up-to-date. In Goldberg the RAM only has to be large enough to hold the updated routines plus the parameter data structure; whereas in Maebayashi the RAM (working memory) must be at least large enough to hold all of the original firmware routines, i.e., it must be at least as large as the ROM. In addition, the

Goldberg system executes routines out of both RAM and ROM; whereas, in the Maebayashi system routines are only executed out of RAM. It is respectfully submitted, therefore, that combining Goldberg and Maebayashi would require a significant change in the principles of operations of one or both references. However, where, as here “the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” MPEP 2143.01. It is respectfully submitted, therefore, that there can be no motivation to combine Goldberg and Maebayashi as suggested, and the combination is improper.

Moreover, even assuming *arguendo* that the combination is proper, the combination still fails to teach the features of the rejected claims. For example, amended claim 1 recites *inter alia* “accepting from said electronic device a request for said data ...; and providing said data to said electronic device.” That is, claim 1 requires that some device or circuit accepts a request, retrieves the requested data from the appropriate memory, and returns the requested data to the requesting electronic device.

In contrast, Goldberg teaches that the electronic device itself, e.g., the processor, determines whether a routine has been updated and where the updated routine is located by executing the processing routine (300). For example, the processor fetches from RAM/ROM and executes the instructions of the various routines of Fig. 1 as determined by the parameter P. There is no disclosure that a processor or other device accepts a request for data from an electronic device or provides the data to the requesting electronic device. Maebayashi also fails to disclose this feature of claim 1. It is respectfully submitted, therefore, that the combination of Goldberg and Maebayashi is distinguished by amended claim 1, as well as by claims 2-6 which depend therefrom.

With respect to claim 13, it is respectfully submitted that there can be no motivation to combine Goldberg and Maebayashi for the reasons set forth above in respect of claim 1. Moreover, assuming *arguendo* that the combination were proper, the

combination fails to teach all of the claim limitations. Claim 13 recite “storing in said random access memory a sequence of execution of selected ones of said modules in said first and second sets.” The Office Action alleges, at page 8, that this feature of claim 13 is taught by Goldberg because it “searches a RAM-located data structure (for the respective locations of the 1st and 2nd sets of modules) and the 2nd (i.e., updated) set of modules can contain calls to execute a sequence of modules).” It is respectfully submitted, however, that the mere fact that Goldberg “can” contain calls to execute a sequence of modules is insufficient to support a *prima facie* case under §103. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01. Accordingly, the combination of Goldberg and Maebayashi is distinguished by claim 13 as well as by claims 14-18 which depend therefrom.

With respect to claim 19, it is respectfully submitted that there can be no motivation to combine Goldberg and Maebayashi for the reasons set forth above in respect of claim 1. Moreover, assuming *arguendo* that the combination were proper, the combination fails to teach all of the limitations of claim 19. For example, claim 19 recites a “controller adapted accept a request for data.” As provided above in respect of claim 1, neither Goldberg nor Maebayashi disclose, teach, or otherwise suggest a controller that accepts a request for data and then provides the possibly updated data. Accordingly, it is respectfully submitted that the combination of Goldberg and Maebayashi is distinguished by claim 19, as well as by claims 20-24 which depend therefrom.

With respect to claim 30, it is respectfully submitted that there can be no motivation to combine Goldberg and Maebayashi for the reasons set forth above in respect of claim 1. Moreover, assuming *arguendo* that the combination were proper, the combination fails to teach all of the claim limitations. Claim 30 recites a structure of first and second memory subsystems including respective first and second processors adapted to communicate as recited in the claim. Specifically, the first processor checks a RAM to determine if data in a mask-ROM has been updated, and if it has been updated, requests

the updated data from the second processor. It is respectfully submitted that this structure is not disclosed, taught, or otherwise suggested by the prior art. For example, Goldberg does not appear to teach multiple processors. Maebayashi, though teaching multiple processors, does not teach that they are interconnected and communicate as recited in claim 30. Therefore, the combination of Goldberg and Maebayashi is distinguished by claim 30, as well as by claims 31-35 which depend therefrom.

With respect to claim 36, it is respectfully submitted that there can be no motivation to combine Goldberg and Maebayashi for the reasons set forth above in respect of claim 1. Moreover, assuming *arguendo* that the combination were proper, the combination fails to teach all of the limitations of claim 36 which recites a base subsystem, including a base microprocessor and a communication subsystem, including a communications microprocessor, adapted to communicate with each other in a specified manner. As provided above in respect of claim 30, this feature of claim 36 is not disclosed, taught, or otherwise suggested by either Goldberg or Maebayashi. It is respectfully submitted, therefore, that the combination of Goldberg and Maebayashi is distinguished by claim 36.

Accordingly, it is respectfully requested that the rejection of claims 1-6, 13-24, and 30-36 under 35 U.S.C. § 103(a) as being unpatentable over Goldberg in view of Maebayashi, be reconsidered and withdrawn.

The rejection of claims 7-12 and 25-28 under 35 U.S.C. § 103(a), as being unpatentable over Goldberg, in view of Maebayashi, and further in view of Cole, is respectfully traversed based on the following.

Amended claim 7 recites *inter alia* "accepting from said electronic device a request for said data ...; and providing said desired version to said electronic device." As provided above in respect of claim 1, this feature of claim 7 is not disclosed, taught, or otherwise suggested by either Goldberg or Maebayashi. It is respectfully submitted, that Cole also fails to teach this feature of claim 7. Therefore, the combination of Goldberg,

Maebayashi, and Cole is distinguished by amended claim 7, as well as by claims 8-12 which depend therefrom.

Claim 25 recites *inter alia* a “controller adapted to accept a request for said desired version of data, and to provide said desired version of data from said nonvolatile reprogrammable memory or said read only memory.” As provided above in respect of claim 7, this feature of claim 25 is not disclosed, taught, or otherwise suggested by Goldberg, Maebayashi, or Cole. Therefore, the combination of Goldberg, Maebayashi, and Cole is distinguished by amended claim 25, as well as by claims 25-28 which depend therefrom.

Accordingly, it is respectfully requested that the rejection of claims 7-12 and 25-28 under 35 U.S.C. § 103(a) as being unpatentable over Goldberg, in view of Maebayashi, and further in view of Cole, be reconsidered and withdrawn.

The rejection of claim 29 under 35 U.S.C. § 103(a), as being unpatentable over Goldberg, in view of Cole, and further in view of Maebayashi, is respectfully traversed based on the following.

Claim 29 depends from claim 25 and, therefore, distinguishes over the combination of Goldberg, Maebayashi, and Cole for at least the same reasons as claim 25.

Accordingly, it is respectfully requested that the rejection of claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Goldberg, in view of Cole, and further in view of Maebayashi, be reconsidered and withdrawn.

The rejection of claims 37-41 under 35 U.S.C. § 103(a), as being unpatentable over Goldberg in view of Schurecht, is respectfully traversed based on the following.

With respect to claim 37, it is respectfully submitted that this claim depends from claim 36 and therefore distinguishes Goldberg for the reasons provided above regarding

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claim 36. It is further submitted that Schurecht adds nothing that would cure the deficiencies of Goldberg. Therefore, the combination of Goldberg and Schurecht is distinguished by claim 37, as well as by claim 38 which depends therefrom.

With respect to claim 39, it is respectfully submitted that the combination fails to teach all of the limitations of claim 39 which recites a base unit, including a base microprocessor and a cordless handset, including a communications microprocessor adapted to communicate in a specified manner. As provided above in respect of claim 36 this feature of claim 39 is not disclose, taught, or suggested by Goldberg. It is further submitted that this feature of claim 39 is also not disclosed, taught, or suggested by Schurecht. Therefore, the combination of Goldberg and Schurecht is distinguished by claim 39, as well as by claims 40-41 which depends therefrom.

Accordingly, it is respectfully requested that the rejection of claims 37-41 under 35 U.S.C. § 103(a) as being unpatentable over Goldberg in view of Schurecht, be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260.

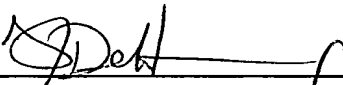
If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be

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construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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